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### **REMARKS**

This is a full and complete response to the Office Action mailed March 7, 2005. The Examiner is respectfully requested to reconsider the application in view of the following amendments and remarks.

Applicants thank the Examiner for the acknowledgment of the claim for foreign priority based on GB0122675.2, and will submit a certified copy within the period specified in 35 U.S.C. § 119(b).

#### **I. SUMMARY OF THE AMENDMENTS**

Prior to entry of the present amendment, claims 1-38 were pending in this application. Claims 1-38 have been canceled. Claims 39-65 are hereby added. The amendments to the application are fully supported in the original Specification. No new subject matter has been added.

Based on the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

#### **II. CLAIM REJECTIONS**

##### ***Under 35 U.S.C. § 101***

The Examiner has rejected Claims 28-31 under 35 U.S.C § 101, asserting that the claimed invention is directed to non-statutory subject matter. It is the Examiner's belief that the

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claims are directed to a method that does not require computer implementation or use of technology to accomplish. Claims 28-31 have been canceled, and thus, the rejection is moot.

***Under 35 U.S.C. § 112***

The Examiner has rejected Claim 23 under 35 U.S.C. § 112, second paragraph. The Examiner states that Claim 23 recites the limitation "the packaging machine" in line 2. Claim 23 has been canceled, and thus, the rejection is moot.

***Under 35 U.S.C. § 102***

The Office Action has rejected Claims 1-19, 24, 28, 31-35, and 37-38 under 35 U.S.C. § 102(c) as being clearly anticipated by *Bozich et al.* (U.S. Patent No. 6,748,285). These claims have been canceled, and so the rejection thereto is moot. Furthermore, the Applicant must point out that the Examiner incorrectly states that *Bozich* discloses a client-server arrangement configured to design a package for at least one object and package the at least one object in the package. At ¶ 7, *Bozich* fails to disclose actually packaging the at least one object in the package. In fact, *Bozich* merely discloses a system that "generates one or more recommendations, referred to as packaging solutions, that identify those components and processes meeting the desired attributes entered by the user." *See e.g.*, Col. 2, ll. 4-6 (underlining added). In contrast, new independent claims 39, 47, 56, and 61 are directed to a client-server arrangement that generates instructions that cause a fabricating device to automatically produce at least part of the package.

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Claims 1-2, 7, 10-12, 17, 19, 21-22, 26-35, and 37-38 stand rejected under 35 U.S.C. § 102(c) as being anticipated by *Gerber* (U.S. Patent No. 6,689,035). These claims have been canceled as well, so the rejection is moot. Again, the Applicant must mention that the Office Action incorrectly asserts that *Gerber* discloses a client-server arrangement configured to design a package for at least one object and package the at least one object in the package, including generating control data for a cutting machine and for controlling a printing device. Contrary to this assertion, *Gerber* also fails to disclose actually packaging the at least one object in the package. Rather, *Gerber* discloses "a system for designing and creating comprehensive models of a package." See e.g., Col. 5, ll. 48-50 (emphasis added).

The Examiner has rejected Claim 36 under 35 U.S.C. § 102(b) as being anticipated by GB 2311759. According to the Examiner, this reference discloses a control signal adapted to actuate motors of a packaging machine. Claim 36 has been canceled, so this rejection is moot.

***Under 35 U.S.C. § 103(a)***

The Examiner has rejected claims 20, 23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Gerber* (or *Bozich et al.*) as applied to claims 11 and 24 above, and further in view of GB2311759. The rejected claims have been canceled, rendering the rejections thereto moot. The Office Action correctly states that *Gerber* (or *Bozich et al.*) does not appear to explicitly disclose generating a control signal for a packaging machine capable or actually packaging the product, it incorrectly concludes that:

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[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gerber (or Bozich et al.) with GB2311759 since teaches GB2311759 that user control inputs relating to package/product design features can be used to control a packaging machine for packaging the product. GB teaches that such a setup allows for changes to be made to the package design very easily by one-touch operation in accordance with a preset program (page 2).

Office Action at ¶ 11. To establish *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See MPEP § 2142; *In re Royka*, 490 F.2d 981 (CPA 1974).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP § 2143.01; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Here, there is no teaching, suggestion, or motivation to combine the references cited by the Examiner. As discussed above, **Bozich** teaches generating recommendations that identify those components and processes meeting the desired attributes, and **Gerber** teaches designing and creating models. GB2311759 teaches a controller for controlling a multiple packing machine. See p. 4, *et seq.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on the applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). However, nothing in any of the references teaches or suggests receiving package design criteria over a communications network

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and generating control data that causes a fabrication device to automatically produce at least part of the package, as recited in new claims 39-65.

#### IV. CONCLUSION

For at least the above reasons, the new claims presented in this application are patentable over the cited references. Applicant respectfully request timely allowance of these claims and issuance of a patent in due course.

A petition for extension of time is submitted herewith, along with the appropriate fee.

Should the Examiner believe that a telephone conference would be useful, please contact the undersigned at the telephone number listed below.

Respectfully submitted,



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